

IN THE

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Supreme Court of the United States CLERK

OCTOBER TERM, 1995

WARNER-JENKINSON COMPANY, INC.,

Petitioner,

—v.—

HILTON-DAVIS CHEMICAL CO.,

*Respondent.*ON WRIT OF CERTIORARI TO THE UNITED STATES
COURT OF APPEALS FOR THE FEDERAL CIRCUIT

**BRIEF OF AMICUS CURIAE
AMERICAN INTELLECTUAL PROPERTY LAW
ASSOCIATION IN SUPPORT OF NEITHER PARTY**

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No. 95-728

WARNER-JENKINSON COMPANY, INC.,*Petitioner,*

—v.—

HILTON-DAVIS CHEMICAL CO.,*Respondent.*ON WRIT OF CERTIORARI TO THE UNITED STATES
COURT OF APPEALS FOR THE FEDERAL CIRCUIT**BRIEF OF AMICUS CURIAE
AMERICAN INTELLECTUAL PROPERTY LAW
ASSOCIATION IN SUPPORT OF NEITHER PARTY****STATEMENT OF INTEREST**

The American Intellectual Property Law Association ("AIPLA") is a national association of more than 10,000 members, primarily attorneys, whose interests and practices lie in the areas of patent, copyright, trademark, trade secret, and other intellectual property law. AIPLA attorneys are employed by private law firms, corporations, universities, and governments, and they represent both patent owners and competitors of patent owners.

The AIPLA has no interest in either of the parties to this litigation or in the outcome of this case, other than its interest in seeking correct and consistent interpretation of the law and litigation procedures relating to patents. The AIPLA has obtained the consent of both petitioner Warner-Jenkinson and respondent Hilton Davis to file this amicus brief.

SUMMARY OF ARGUMENT

A United States patent, like a plot of real estate, is a property right circumscribed by a defined boundary. For any entity contemplating an investment, it is as important to know with certainty where lie the boundaries of its competitor's patent as it is to know the boundaries of its neighbor's land. Trespass on either kind of right risks loss of the investment.

The exclusionary right accorded by a patent is a grant given and enforced by the United States government. Since 1870, the applicable statutes have required that every patent contain a metes and bounds description, in the form of claims that particularly point out and distinctly claim the scope of that exclusive right. The examination process that results in the grant of the patent, focuses on those claims, and has as its principal objective defining with precision in the words of the claims the parameters of what the applicant invented and what is patentable to him under the various statutory criteria. In that proceeding, the applicant is free to choose the terms and scope of the claims, and does so with the expectation that the language agreed on will delineate the right to exclude others.

Yet, even after that exercise, persons who seek to know the limits of the patent property right cannot simply rely on the literal meaning of the metes and bounds description. Patents are accorded a scope beyond the literal terms of their claims under the doctrine of equivalents, a judge-made doctrine that blurs the sharp boundary lines that the statute mandates. The head-on conflict between the two has divided prior panels of this Court and the Court of Appeals for the Federal Circuit.¹

This case provides the opportunity to settle definitively to what extent, and in what manner, the doctrine of equivalents can be applied without contravening the statutory requirement that the patent claims distinctly define the invention. The AIPLA believes the doctrine must remain available to patentees to assure that patent infringement will be determined by substantive merit rather than formalistic literalism. But the AIPLA nevertheless urges this Court to come down on the side of minimizing uncertainty by assuring that "equivalents" will be given both limited scope and consistent application. Specifically, the AIPLA recommends the following conclusions:

1. The Federal Circuit was correct when it held that infringement under the doctrine can be found only when the departure from the literal scope of the claim was insubstantial.
2. The exclusivity provided by a patent must be predictable and consistent as against all prospective infringers. Therefore, neither the application of the doctrine nor the scope of equivalents accorded should depend on equities that are peculiarly related to the acts or intent of a specific infringer.
3. Determining the range of equivalents to which a patent claim is entitled is a determination of its scope—its construction or interpretation. It is therefore the function of the judge to instruct the jury on how far equivalency expands the effective scope of the claim and the function of the jury then to determine whether the accused device falls within that court-defined area.

¹ The landmark decisions of this Court, *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1853) and *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605 (1950) ("*Graver Tank II*") were accompanied by vigorous dissents. The Federal Circuit *en banc* hearing in the present case produced a *per curiam* opinion joined by seven judges, a single-judge concurrence, and five judges dissenting in three separate opinions.

ARGUMENT

I. Infringement Under The Doctrine Of Equivalents Must Require That Any Departure From The Literal Claim Is Insubstantial

The claims of a patent have been likened to a metes and bounds description of real property. *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917). They are intended to give notice to the public, and to competitors in particular, of the outer limits of the area within which the patentee can invoke the power of a court to enforce the government-granted right to exclude competitors. The claims inform competitors what they can and cannot do. It is the words of the claims that give definiteness to the boundaries of exclusivity.

It has long been recognized, however, that, if a patentee were limited strictly to the words of the claim, competitors might appropriate "the invention" without infringing "the claims". *Winans v. Denmead*, 56 U.S. (15 How.) 330, 341-343 (1853). Therefore, if we are to avoid the undesirable consequences that result when a literal claim reading is too harsh, the enforceable scope of the claim must, in appropriate circumstances, be expanded beyond that which would otherwise be encompassed by the words themselves in order for the patentee to receive meaningful enjoyment of the patent right. A major objective of this Court's precedent and the Federal Circuit's decision in the instant case was to articulate a meaningful standard that achieves the appropriate balance between the inherently antagonistic principles of clear demarcation of the patent right and flexibility in the search for fairness.

This Court's most recent restatement of the doctrine of equivalents, in *Graver Tank II*, endorsed the three-part test for equivalency previously expressed in *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 42 (1929) ("if [the accused device] performs substantially the same function in substantially the same way to obtain the same result"). 339 U.S. at

608. After *Graver Tank II*, "function, way, result" became the touchstone for every equivalency determination.

The majority below acknowledged "the so-called triple identity, or function-way-result, test" as one method for measuring the substantiality of the differences between the claimed invention and the product accused of infringement, 62 F.3d at 1518, but held that test is not the entirety of the inquiry required. Rather, it said, the overriding and eventually dispositive question is whether departure from the literal scope of the claims is substantial or insubstantial:

With this case, this court explicitly holds that the application of the doctrine of equivalents rests on the substantiality of the differences between the claimed and accused products or processes, assessed according to an objective standard.

62 F.3d at 1518.

The AIPLA believes that the "substantiality of the differences" standard is not only consistent with this Court's precedent, it is required by it. This Court has stressed that infringement under the doctrine of equivalents turns on whether the difference between the accused product and the patent claim is "substantial and not merely colorable," *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 286 (1904). The *Graver Tank II* opinion nowhere says that "function, way, result" has dispositive significance. To the contrary, the majority opinion is replete with references to insubstantial differences: "unimportant and insubstantial changes and substitutions . . . adding nothing"; "minor variations"; "so insubstantial"; "colorable only". 339 U.S. at 607, 610, 612.

While fairness to the patentee is served by according the claims a scope that includes departures from the literal scope that are colorable and insubstantial, it does not require extension beyond those limits. There is no suggestion in *Graver Tank II*, or any other decision of this Court, that the "function,

way, result" test should provide a vehicle to stretch patent claims far enough to encircle distinctions that embody meaningful, substantial differences.

The majority below was correct in holding that similarity of function, way and result alone is not always enough for infringement by equivalents—for that similarity can be present even where there are substantial differences between the product accused of infringement and the invention of the patentee's claims. Judge Lourie, while a dissenter below, agreed with the majority—and the precedents from this Court—that substantiality of the differences need always be considered, and provided a pertinent illustration of why that is so:

One can also consider the example of the well-known analgesics aspirin and ibuprofen. These compounds have the same function (to provide analgesia, anti-inflammatory activity, and lower temperature), do so in the same way (by inhibiting prostaglandin synthesis), and give the same results (kill pain, relieve inflammation, and lower fever). Yet, they have different structures, which makes them different compounds, and no knowledgeable person would consider that a claim to aspirin would be infringed by the sale of ibuprofen.

62 F.3d at 1546.

Reading *Graver Tank II* to endorse or permit extension of the claim beyond insubstantial differences would ignore much of the reasoning clearly expressed in that opinion, give the patentee control over things that are not properly within his invention, and vitiate the statutory requirement of distinctness. The "substantiality of differences" standard applied by the majority below is consonant with this court's precedent and appropriately reconciles the need for certainty with the need for fairness.

II. The Determination Of The Breadth Of Protection Accorded Patent Claims Must Be Independent Of The Defendant

The doctrine of equivalents was created to avoid placing the inventor "at the mercy of verbalism". *Graver Tank II*, 339 U.S. at 607. It is "equitable" in the sense that it is founded on a search for fairness to patentees, to avoid depriving inventors of the benefit of his invention and to prevent a fraud on a patent. *Id.* at 607-08.

However, fairness to patentees wrought by the flexibility provided in the doctrine of equivalents comes at the expense of certainty. To the extent the clear literal boundaries of the claims are made fluid and subject to a broadening interpretation in litigation, it becomes commensurately more difficult for the public to know what infringes and what does not.

Moreover, the scope of a patent—whether literal or by operation of equivalency—must remain constant. If the pursuit of fairness turns its focus to the motives and acts of the accused infringer as a measure of what infringes, consistency is lost. Motive, in patent cases, is irrelevant to whether infringement exists. It has application only in fashioning an appropriate remedy.

For those reasons, the AIPLA believes, and urges this Court to hold, that the scope of the claims under the doctrine of equivalents is independent of the identity and subjective considerations peculiar to the specific alleged infringer.

Although fairness to the patentee has an equitable flavor, the scope of a claim under the doctrine of equivalents is properly determined by application of objective criteria: The content of the prior art, the description in the specification, statements made and positions taken in the pre-grant administrative prosecution proceedings, the pioneer or incremental nature of the invention, and subsequent developments in the art. If the focus of the analysis shifts from such objective criteria to subjective ones, such as the intent of the accused

infringer, then it is possible to have the anomalous result of a device being held infringing when made by one competitor yet not infringing when made by another. The AIPLA urges that the determination of whether a particular departure from the literal scope of a claim is substantial should be the same irrespective of the identity and motives of the defendant. As the majority opinion below correctly pointed out:

The Supreme Court applied the doctrine of equivalents in *Graver Tank* to prevent "fraud on a patent," 339 U.S. at 608, 70 S.Ct. at 856, not fraud by the accused infringer. As *Graver Tank* demonstrates, preventing "fraud on a patent" involves an objective assessment of the substantiality of the differences between the claimed and accused products or processes.

62 F.3d at 1519.

In *Graver Tank II*, this Court referred to party-specific elements—whether the accused infringer was guilty of copying as opposed to having independently developed the accused product. 339 U.S. at 607-09. The AIPLA agrees with the majority opinion below that such party-specific factors may sometimes be considered, but should be applied with caution, and only for the purpose of assessing whether the differences between the literal claim scope and the accused device are insubstantial and, (as a wholly separate matter) whether punitive damages are appropriate. The mental state of the infringer should *not* be used as a factor to expand or contract the scope of equivalents to which a claim is entitled. A patent claim should have no broader effective scope against a willful copyist than it does against a good faith innovator.

As the Court of Appeals pointed out, neither intent nor knowledge is an element of infringement. 62 F.3d at 1519, 1520. One who designs a product with no knowledge of a patent is as much an infringer as one who deliberately copies. The question is whether the product infringes, not how the accused infringer developed the product. Knowledge and

intent should not be accorded independent status that can vary the scope of equivalents. If the accused infringer copied the patented invention or it made changes which even it recognized were insubstantial, that could be relevant evidence tending to show that the differences lack substance. But that evidence would not be party-specific. It would have evidentiary value with respect not only to the actor's own product but with respect to similar products of other competitors as well.

The AIPLA believes that, while the doctrine of equivalents remains an important part of the patent system, it is equally important that it be applied in a fashion that reduces, as much as possible, the uncertainty and risk of inconsistency that it introduces. This can be accomplished by making its application dependent on factors which are not specific to the particular litigants. Factors such as motive and knowledge may be taken into account in determining damages, but not in determining the scope of coverage to which the claims are entitled.

III. Determining The Scope Of The Claims Under the Doctrine of Equivalents Is For The Court

One of the points noted in the Federal Circuit's *Markman* opinion² that argues for allocating the claim interpretation function to the judge is that a patent is a government grant of exclusivity, the scope of which should be determined with certainty and consistency. 52 F.3d at 978-79. Indeed, a patent is the result of a determination made by a government agency. The very essence of the examination process is the application by the United States Patent and Trademark Office of prescribed statutory criteria to arrive at and grant, under government seal, the claim that the agency has determined defines the ambit of the justified exclusionary right. Analo-

² *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (en banc), cert. granted, ___ U.S. ___, 116 S.Ct. 40 (1995) (No. 95-26).

gies drawn to the interpretation of statutes, agency rulings, and other government actions are apt.

Determining what is included within the effective scope of a claim under the doctrine of equivalents could be viewed in either of two ways.

If deciding the permitted scope of equivalence is treated as a question of claim construction, the court should do it and present that defined claim scope to the jury, after which the jury's role should be to resolve any fact disputes as to whether the accused process or device is within the fence established by the court. That procedure produces a record of how and why the equivalence was determined and a consistency of definition from case-to-case.

Under the majority view below, however, equivalence is not a question of claim interpretation. The court determines only the literal scope of the claim; the jury decides whether an accused device or process that does not meet that literal definition is nonetheless equivalent to it. That alternative provides no record of the analysis made and carries the risk that precisely the same variant can be held equivalent in one case, but non-equivalent in a later one, with both verdicts largely insulated from appellate revision due to the "substantial evidence" standard.

The need for certainty and the rationale for having judges interpret patent claims apply to *all* determinations of their scope, whether literal or under the doctrine of equivalents. All claim scope determinations involve considering the same elements—the words of the claim, their meaning to persons skilled in the art, the description in the patent specification, statements made and positions taken during the prosecution, and the prior art. It is simply illogical and inconsistent to require that the court consider all of those elements to give the jury a definitive *literal* meaning of the claim, but then allow the jury to take a second look at the same elements and thereby find an "equivalent" exclusionary right of potentially far wider scope.

Precedent does not mandate that illogical result. Nor does allocating to the court all aspects of claim interpretation—literal and equivalent—mean that the jury is left out of the case or relegated to a rubber stamp role. Questions of *what the claims are* should be decided by the judge. Factual issues of *what the accused device or process is*, and whether it falls within the judge-defined claim scope, are reserved to the jury. For example, in the case under review here, the patent claim recites a "pH" range of 6.0 to 9.0. The judge, applying all the factors bearing on claim interpretation, could find that the claim was not limited to that literal scope, but was entitled to a range of equivalents spanning 5.0 to 9.0. With that construction fixed, the jury would decide (if there were a disputed issue of fact) whether the "pH" of the accused process was within that range. If the patentee contended the defendant used a pH of 5.2, and the infringer contended it was 4.8, the jury would resolve that fact issue.

That procedure parallels how literal infringement is determined, and it is supported by precedent. In *Winans*, 56 U.S. at 338, this Court parsed the functions and roles of the judge and jury in the infringement determination process:

On such a trial, two questions arise. The first is, what is the thing patented; the second, has that thing been constructed, used, or sold by the defendants.

The first is a question of law, to be determined by the court, construing the letters-patent, and the description of the invention and specification of claim annexed to them. The second is a question of fact, to be submitted to a jury.

This Court concluded that "equivalents" were included in the scope of the claim as a matter of interpretation under the law (56 U.S. at 342, 343, *emphasis added*):

It is generally true, when a patentee describes a machine, and then claims it as described, that he is understood to intend to claim, and *does by law actually*

cover, not only the precise forms he has described, but all other forms which embody his invention. . . .

* * * *

Patentees sometimes add to their claims an express declaration, to the effect that the claim extends to the thing patented, however its form or proportions may be varied. But this is unnecessary. *The law so interprets the claim* without the addition of these words.

* * * *

And, therefore, the patentee, having described his invention, and shown its principles, and claimed it in that form which most perfectly embodies it, is, *in contemplation of law, deemed to claim every form* in which his invention may be copied, unless he manifests an intention to disclaim some of those forms.

When the *Winans* Court then added:

Whether, in point of fact, the defendant's cars did copy the plaintiff's invention, in the sense above explained, is a question for the jury, and the court below erred in not leaving that question to them upon the evidence in the case, which tended to prove the affirmative[.]

56 U.S. at 344, that did not mean that the entire question of what equivalents were embraced by the claim was taken from the Court and shifted to the jury. It simply meant that, after the Court decided the legal scope of the claim, including its deemed-in-law range of equivalents, the jury was then required to ascertain whether the accused device fell within or without that scope.

In its *en banc* decision in *SRI International*³, the Federal Circuit correctly described the two-step approach to the

infringement determination, with separate judge and jury functions:

Contrary to what MEI's counsel wrote the district court, claims are not construed "to cover" or "not to cover" the accused device. That procedure would make infringement a matter of judicial whim. It is only after the claims have been construed without reference to the accused device that the claims, as so construed, are applied to the accused device to determine infringement.

* * * *

Infringement, literal or by equivalence, is determined by comparing an accused product not with a preferred embodiment described in the specification, or with a commercialized embodiment of the patentee, but with the properly and previously construed claims in suit.

775 F.2d at 1118, 1121.

Although the *en banc* majority in *SRI International* recognized that all aspects of claim interpretation are reserved to the Court, the *en banc* majority in the present case held that all aspects of equivalency are reserved to the jury. It did that because it (i) recognized that a finding of equivalence is a finding of fact (which is true but not determinative) and (ii) treated the doctrine of equivalents as though it had no impact on claim scope (which is not true). 62 F.3d at 1520-21, 1528.

That what is equivalent is a question of fact is beyond dispute. This Court plainly said so in *Graver Tank II*⁴. 339 U.S. at 609. But not all fact issues are for the jury. As the *Winans* Court noted, getting to a proper construction of the claim (i.e. "determin[ing] what is the thing patented") requires the Court to make a number of factual inquiries. 56 U.S. at 338.

³ *SRI International v. Matsushita Electric*, 775 F.2d 1107 (Fed. Cir. 1985) (*en banc*).

⁴ *Graver Tank II* did not discuss the respective roles of judge and jury because the trial was to the bench.

In this, as in most patent cases, founded on alleged improvements in machines, *in order to determine what is the thing patented*, it is necessary to inquire.

1. What is the structure or device, described by the patentee, as embodying his invention.
2. What mode of operation is introduced and employed by this structure or device.
3. What result is attained by means of this mode of operation.
4. Does the specification of claim cover the described mode of operation by which the result is attained.

56 U.S. at 338-39 (emphasis added).

Deciding the permissible range of equivalents is an exercise in determining the effective scope of the claim in issue. As *Winans* says, the inclusion of equivalents is the way the *law interprets the claim*. *Id.* at 343.

The *Hilton Davis* majority said:

This dissent errs, however, in arguing that application of the doctrine of equivalents enlarges the claim scope. Instead the doctrine of equivalents provides the same protection to the substance of the claim scope provided by the doctrine of literal infringement.

62 F.3d at 1528.

If the majority was correct that applying the doctrine of equivalents does not enlarge the claim scope, that conclusion can only be based on what this Court said in *Winans*—that the *law interprets the claim to cover both its literal wording and things equivalent to it*.⁵ If that is the effect of the law on the

⁵ The majority could not have meant that the doctrine of equivalents does not expand the effective reach of the claim beyond its *literal* scope. Here, the claim recites a pH range of 6.0 to 9.0, yet Warner-Jenkinson was held an infringer under the doctrine because it used a pH of 5.

claim, then one cannot logically separate the literal scope from the legally-effective scope, and both are for the court to decide.

In *Wilson Sporting Goods Co. v. David Geoffrey & Associates*, 904 F.2d 677 (Fed. Cir.), *cert. denied*, 498 U.S. 992 (1990), the Federal Circuit (Rich, J.) similarly said that applying the doctrine of equivalents did not change the scope of the claims, but only expanded the right to exclude. Yet, despite that semantic distinction, the Federal Circuit fashioned a revised, hypothetical patent *claim* that literally included the allegedly equivalent device, as the only practical way to test whether according that scope of exclusivity was permissible in light of the prior art. The Court concluded that testing the allowable range of equivalents in the context of a redefined claim was preferable to looking at the allegedly infringing device because it “permits a more precise analysis than determining whether an *accused product* (which has no claim limitations on which to focus) would have been obvious in view of the prior art.” *Id.* at 684 (emphasis in original).

Infringement is the unauthorized making, using, selling, offering to sell, or importation of a patented invention. 35 U.S.C. § 271(a). The patented invention is the thing that is particularly pointed out and distinctly claimed in the claims found at the end of the patent document. 35 U.S.C. § 112. The exclusionary right granted by the patent must, therefore, be coterminous with the interpretation of what those claims mean, and interpretation of the claims is exclusively for the court.

Relegating the determination of the scope of equivalents to the court is no more unworkable than having the court decide any other issue of claim interpretation. The litigants will identify the claim element or limitation in issue. The court will consider the submissions of the parties relevant to how far and wide that limitation can be extended by equivalency (just as the court decides the meanings of technical terms in the claims) and so instruct the jury.

In some cases, defining the claim scope under the doctrine of equivalents will resolve the question of infringement and leave nothing for the jury to decide (just as deciding the literal scope of the claim would resolve literal infringement when there is no fact issue about what the accused device or process is or how it works). But that is entirely appropriate, because it is the province of the court to declare the scope of the exclusive right as a question of law, and the province of the jury to decide whether the infringer's activities fall within that right as a question of fact. As this Court explained in *Sanitary Refrigeration*, when there is no dispute over what is the structure and operation of the accused device, infringement under the doctrine of equivalents reduces to a question of law:

Furthermore upon the undisputed evidence the question of infringement resolves itself in each [of the cases under review] into one of law, depending on a comparison between the structure disclosed on the face of the patent and the device shown in the Dent latch, and the correct application thereto of the rule of equivalency.

280 U.S. at 36.

CONCLUSION

This Court should affirm the majority opinion below in its holdings that (i) the basic standard for determining the scope to which a patent claim is entitled under the doctrine of equivalents is "insubstantial difference" and (ii) the only evidence considered to determine whether that standard is met should be objective, not the state of mind of the accused infringer.

This Court should reverse the majority opinion below with respect to its holding that equivalence is wholly an issue for the jury and should hold that the scope of a patent claim

under the doctrine of equivalents is an issue of claim interpretation to be made by the court.

Respectfully submitted,
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